



UNITED STATES PATENT AND TRADEMARK OFFICE

DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES
BOX INTERFERENCE, WASHINGTON, D.C. 20231

Filed by: Richard Torczon
Telephone: (571) 272-9797
Facsimile: (571) 273-0042

MAILED

APR - 1 2005

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Applicants: Maeda et al.
Application No.: 09/750,116
Filed: 12/29/00
For: (Meth) acrylate derivative,
polymer and photoresist composition
having lactone structure, and method
for forming pattern by using it

The above-identified application or patent has been forwarded to the Board of Patent Appeals and Interferences because it is adjudged to interfere with another application or patent. An interference has been declared. The interference is designated as No. 105,297.

Notice is hereby given the parties of the requirement of the law for filing in the Patent and Trademark Office a copy of any agreement "in connection with or in contemplation of the termination of the interference." 35 U.S.C. § 135(c).

Richard Torczon
Administrative Patent Judge

Mail Stop INTERFERENCES
P.O. Box 1450
Alexandria, Virginia 22314-1450
Tel: 571-272-9797
Fax: 571-273-0042

Paper 1

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 105,297

NEC CORPORATION

(09/750,116),
Junior Party,

v.

MAILED

APR - 1 2005

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

SHIN-ETSU CHEMICAL Co. LTD.
(6,280,898 B1),
Senior Party.

DECLARATION - Bd.R. 203(b)

By TORCZON, Administrative Patent Judge.¹

A. Declaration of interference

An interference is declared (35 U.S.C. 135(a)) between the captioned parties.

Details of the application, patent, count, and claims designated as corresponding to the count appear under headings E and F of this DECLARATION.

B. Administrative patent judge designated to administer the contested case

Administrative Patent Judge Richard Torczon has been designated to administer this contested case. 37 CFR § 41.104(a) [Bd.R. 104(a)].

¹ As part of Board efforts under the Government Paperwork Elimination Act, signatures on papers originating from the Board are being phased out in favor of a completely electronic record. Consequently, in this case papers originating at the Board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 C.F.R. § 10.18.

C. Standing order

A copy of the Trial Section STANDING ORDER [SO] (Paper 2) accompanies this DECLARATION. The STANDING ORDER applies to this contested case.

D. Conference call to set dates

A telephone conference call to set dates for action in this contested case is scheduled for **2 p.m. (Eastern) on 25 May 2004**. (The Board will initiate the call.)

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile (SO ¶ 4.5) a list of the motions (Bd.R. 120; Bd.R. 204; SO ¶ 26) the party intends to file.

A sample schedule for taking action during the motion phase appears as Form 2 in the STANDING ORDER. Counsel are encouraged to discuss the schedule prior to the conference call and to agree on dates for taking action. A typical motion period lasts approximately eight (8) months. Counsel should be prepared to justify any request for a shorter or longer period.

The Board is conducting a pilot program in electronic filing of papers (Bd.R. 106(d)(2)). The procedure is explained in University of New Mexico v. Fordham Univ., No. 104,761, Paper 21 (2001).² Counsel should be prepared to discuss participation in the pilot program.

² <http://www.uspto.gov/web/offices/dcom/bpai/its/104761-021.pdf>.

E. The parties to this interference

Junior Party

Application: 09/750,116 [116], filed 29 December 2000

Title: (Meth) acrylate derivative, polymer and photoresist composition having lactone structure, and method for forming pattern by using it

§102(g) benefit: None

Senior Party

Patent: 6,280,898 B1 [898], issued 28 August 2001
(09/404,763, filed 24 September 1999)

Title: Novel lactone-containing compounds, polymers, resist compositions, and patterning method

§102(g) benefit: None

F. Count and claims of the parties

Count 1

The (meth) acrylate derivative of 116 claim 1 or the lactone-containing compound of 898 claim 1.

The claims of the parties are:

NEC: 1-23

Shin-Etsu: 1-21

The claims corresponding to Count 1:

NEC: 1-5, 8-19 & 21-23

Shin-Etsu: 1-20

The claims not corresponding to Count 1:

NEC: 6, 7 & 20

Shin-Etsu: 21

G. Heading to be used on papers

Addendum 1 provides the heading that shall be used on all papers filed in the contested case. See SO ¶ 7.2.1.

The range of exhibit numbers is assigned as follows (Bd.R. 154(c)(1); SO ¶ 20.2.1):

Shin-Etsu Chemical Co. Ltd.: 1001-1999.

NEC Corporation: 2001-2999.

H. Order form for requesting file copies

When requesting copies of files, use of Addendum 2 (SO Form 4) will greatly expedite processing of the request. Please attach a copy of Part E of this DECLARATION with a hand-drawn circle around the patents and applications for which a copy of a file wrapper is requested.

I. Required paragraph for affidavits and declarations

The Board has recently experienced a rash of cases in which a witness has belatedly advanced reasons why he or she would be unable to appear for cross examination at a reasonable time and place in the United States. Consequently, the Board is requiring the following paragraph to be included on the signature page of all affidavits (including declarations) filed in this case to prevent surprise and hardship to the party relying on the testimony of the witness:

In signing this affidavit/declaration, I recognize that the affidavit/declaration will be filed as evidence in a contested case before

the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office. I also recognize that I may be subject to cross examination in the case and that cross examination will take place within the United States. If cross examination is required of me, I will appear for cross examination within the United States during the time allotted for cross examination.

Enclosure: Copy of STANDING ORDER (Paper 2).

cc (via overnight delivery):

For NEC Corporation:

Sean McGinn
McGINN & GIBB, PLLC
8321 OLD COURTHOUSE RD STE 200
VIENNA VA 22182-3817
Tel: 703-761-4100
Fax: 703-761-2375

For Shin-Etsu Chemical Co. Ltd.:

Anthony J. Zelano
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD STE 1400
ARLINGTON VA 22201
Tel: 703-243-6333
Fax: 703-243-6410

Interference No. 105,297
NEC Corporation v. Shin-Etsu Chemical Co. Ltd.

Paper 1
Page 6

ADDENDUM 1

Filed on behalf of: [Name of Party] Paper No. [Leave blank]
By: [Name of lead counsel]
Name of backup counsel
Street address
City, State, and ZIP Code
Tel:
Fax:]

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
(Administrative Patent Judge Torczon)**

**NEC CORPORATION
(09/750,116),
Junior Party,**

v.

**SHIN-ETSU CHEMICAL CO. LTD.
(6,280,898 B1),
Senior Party.**

Patent Interference No. 105,297

TITLE OF PAPER

ADDENDUM 2

FILE COPY REQUEST
Patent Interference No. 105,297

Attach a copy of section E of this DECLARATION to this REQUEST. On the copy, circle each patent and application that you are requesting. Include the following information to facilitate processing of this REQUEST:

1. Charge fees to USPTO Deposit Account No. _____

2. Complete address,³ including street, city, state, zip code, and telephone number:

3. Telephone, including area code: _____

³ Provide a street address, NOT a Post Office Box. The Office of Public Records uses a commercial overnight delivery service rather than the United States Postal Service to deliver file copies.

INTERFERENCE DIGEST

Interference No. 105,297

Paper No. 12

Name: Katsumi Maeda et al.

Serial No.: 09/750,116

Patent No.

Title: (Meth) acrylate derivative, polymer and photoresist composition having lactone structure, and method for forming pattern by using it

Filed: 12/29/00

Interference with Hasegawa et al.

DECISION ON MOTIONS

Administrative Patent Judge, _____ Dated, _____

FINAL DECISION

Board of Patent Appeals and Interferences, favorable Dated, 1-15-05

Court, _____ Dated, _____

REMARKS

